

06/13/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 17
EWH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Manufactura de Tabacos (MATASA), S.A.

Ser. No. 75/347,820

Julie A. Greenberg of Gifford, Krass, Groh, Sprinkle,
Anderson & Citkowski

Ronald McMorrow, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Hanak, Wendel and Bottorff, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

On August 27, 1997 applicant's predecessor filed an
application seeking to register the mark PRIMERA DE
NICARAGUA for "cigars made from Nicaraguan tobacco."
Applicant's predecessor claimed a first use date of May
1995, and a first use date "in commerce among the several
states" of May 1995.

Ultimately, the Examining Attorney refused registration
pursuant to Section 2(e)(2) of the Trademark Act on the
basis that applicant's mark is primarily geographically
descriptive of applicant's goods.

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When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs and were present at a hearing held on March 27, 2001.

The facts in this case are not in serious dispute. Applicant's cigars are made in Nicaragua. Nicaragua is the name of a country which is neither remote nor obscure. Moreover, the Examining Attorney has made of record evidence demonstrating that other companies manufacture Nicaraguan cigars.

However, the issue before us is not whether the NICARAGUA portion of applicant's mark is primarily geographically descriptive. Rather the issue is whether the mark in its entirety (PRIMERA DE NICARAGUA) is primarily geographically descriptive.

As a general rule, the addition of descriptive terminology to a word which is primarily geographically descriptive results in a composite which is still primarily geographically descriptive. In re California Pizza Kitchen, 10 USPQ2d 1704, 1705 (TTAB 1988). Thus, the issue in this case is essentially whether the terminology PRIMERA DE is merely descriptive of applicant's cigars. In making this

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determination, we are guided by the proposition that "marks that are merely laudatory" are generally regarded as being descriptive. 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 11:17 at page 11-21 (4th ed. 2000)(emphasis added).

In arguing that PRIMERA DE is at most suggestive, and not descriptive, of its goods, applicant makes three arguments. First, applicant notes that it now owns Registration No. 2,134,797 for the mark LA PRIMERA for cigars. In this registration there is a statement that LA PRIMERA is translated into English as "the first." Second, applicant relies upon the affidavit of its predecessor in interest (Benjamin Gomez) who states in paragraph one that the translation of the trademark PRIMERA DE NICARAGUA is "first of Nicaragua." Finally, applicant notes that the Examining Attorney is in agreement that the primary translation of the mark PRIMERA DE NICARAGUA is indeed the "first of Nicaragua." The Examining Attorney merely goes on to argue that a secondary translation of the mark is the "best of Nicaragua." (Examining Attorney's brief page 2).

If the primary meaning of the Spanish word "primera" was indeed the "best," then we would find that this is a

merely laudatory term, and hence was descriptive. However, there appears to be no dispute that the primary definition of the Spanish word "primera" is not the "best," but rather the "first." In determining whether a term is merely laudatory and hence descriptive, or instead is only somewhat laudatory and hence just suggestive, very fine distinctions have to be made. However, based upon this record, we find that the primary translation of "primera" is not merely laudatory, and hence is at most highly suggestive.

Accordingly, we find that applicant's mark PRIMERA DE NICARAGUA in its entirety is not primarily geographically descriptive. Of course, the NICARAGUA portion of applicant's mark is clearly primarily geographically descriptive, and must be disclaimed. At the oral hearing, counsel for applicant advised us that applicant would be willing to disclaim the NICARAGUA portion of this mark. Accordingly, applicant will be allowed 30 days in which to submit such a disclaimer.

Two final points merit discussion. First, in view of our determination that applicant's mark in its entirety is not primarily geographically descriptive, we need not consider the sufficiency of applicant's claim of acquired

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distinctiveness pursuant to Section 2(f) of the Trademark Act.

Second, we would be remiss if we did not note that just a few years ago this Board found that the mark HAVANA PRIMO was primarily geographically deceptively misdescriptive for rum not made in Havana. In re Bacardi & Co. Ltd., 48 USPQ2d 1031 (TTAB 1997). However, in that case the word in question was not "primera," but rather was "primo." Moreover, in the Bacardi case, the only definition of the word "primo" was "slang a. first-class, b. highly valuable or most essential." Bacardi, 48 USPQ2d at 1034, footnote 10. Obviously, based upon the foregoing definitions, the slang term "primo" was clearly merely laudatory.

Decision: The refusal to register is reversed provided that within 30 days of the issuance of this opinion applicant submits a paper disclaiming exclusive rights to the NICARAGUA portion of its mark.